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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,608	04/07/2000	Luke Hohmann	1531.0300001	9652

7590 01/26/2004

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

13

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,608

Applicant(s)

HOHMANN ET AL.

Examiner

Quang N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Detail Action

1. This Office Action is in response to the Response Amendment A filed on 12/15/2003. Claims 2-20 have been added as new claims. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Rivette et al. (US 5623,679), herein after referred as Rivette.**

4. As to claim 1, Rivette teaches a method and system for creating and manipulating text and image documents in electronic form for display, comprising:

a database (UNIX database 11 and library 30 of Fig. 1) having stored therein at least one intellectual asset protocol (Standardized Generalized Markup Language

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SGML, which specifies the data rules and formats for the Equivalent File, maybe utilized to create a compound document that contains both the Equivalent File and bit scanned images of tables, flow charts, equation, etc.), wherein said at least one intellectual asset protocol defines at least one data exchange set of rules and formats (types of synchronization information) for a type of intellectual asset data object (patent documents) (Rivette, Fig. 1, C11: L36-67, C12: L1-8, C17: L40-67 and C18: L1-54); and

at least one engine, wherein said at least one engine determines whether an intellectual asset data object of said type conforms to said intellectual asset protocol (Rivette, C21: L3-37).

5. As to claim 2, Rivette teaches the system of claim 1, wherein said type of said intellectual asset data object is selected from the group consisting of a patent, a patent application, a trademark, a trademark application, a copyright, a trade secret, a license agreement, and a joint venture agreement (Rivette, C10: L11-17).

6. As to claim 3, Rivette teaches the system of claim 1, wherein said database is accessible through the Internet using personal computers in a home or office environment (Rivette, C1: L31-39).

7. As to claim 4, Rivette teaches the system of claim 1, wherein said database is relational, i.e., indexed database (Rivette, C20: L8-17 and C25: L50-57).

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8. As to claim 5, Rivette teaches the system of claim 1, wherein said database supports hypertext references such as SGML (Rivette, C17: L40-61).

9. As to claim 6, Rivette teaches the system of claim 1, wherein objects within said protocol conform to at least one Extended Markup Language (XML) Document Type Definition (DTD) (Rivette, C17: L40-61).

9. As to claim 7, Rivette teaches the system of claim 6, wherein said DTD comprises a union of structured bibliographic data of said intellectual asset data objects (Rivette, C15: L1-9 and C16: L7-31).

10. As to claim 8, Rivette teaches the system of claim 1, wherein said system further comprises an input for receiving intellectual asset data objects (extracting/receiving PTO text files and PTO image files from PTO magnetic tapes), a format of said input intellectual asset data objects being normalized for entry into said database (PTO text and image files being paginated to produce and index the corresponding PTO Equivalent Files which are being stored in the library 30 and the database 11 of Fig. 1) (Rivette, C11: L10-67 and C12: L1-8).

11. As to claim 9, Rivette teaches the system of claim 1, wherein said system further comprises an output for presenting information from said intellectual asset data objects,

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said information from said input intellectual asset data objects being formatted according to a DTD (Rivette, Fig. 38, C4: L12-54 and C11: L61-64).

12. Claim 10 is a corresponding combination system claim of system claims 1 and 8-9; therefore, it is rejected under the same rationale.

13. Claims 11-17 are corresponding system claims of system claims 2-7; therefore, they are rejected under the same rationale.

14. Claims 18-19 are corresponding method claims of system claims 10 and 13; therefore, it is rejected under the same rationale.

15. Claim 20 is a corresponding computer readable media claim of method claim 18; therefore, it is rejected under the same rationale.

Response to Arguments

16. In the remarks, applicant argued in the substance that

(A) The application is a continuation in part of USSN 09/057,557, filed April 9, 1998, less than one year later than the issue date of the applied reference, US 5,623,679, April 22, 1997.

As to point (A), claim 1 rejection as being anticipated under 35 U.S.C. 102(b) has been withdrawn.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER

